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TO:	FROM:
Kumar, Srilakshmi K., Examiner	S. Jared Pitts, Reg. No. 38,579
COMPANY:	DATE:
USPTO	JULY 22, 2005
FAX NUMBER:	TOTAL NO. OF PAGES INCLUDING COVER:
571 273-8300	9
PHONE NUMBER:	SENDER'S REFERENCE NUMBER:
703-308-4357	028.1108Z1
RE:	RECIPIENT'S REFERENCE NUMBER:
Transmittal; Notice of Appeal; Pre-Appeal Brief Request for Review; and Arguments Accompanying Pre-Appeal Brief Request for Review.	09/176,639

URGENT

FOR REVIEW

PLEASE COMMENT

PLEASE REPLY

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NOTES/COMMENTS:

**EXAMINING GROUP ART UNIT 2675
FORMAL COMMUNICATION
INTENDED FOR ENTRY**

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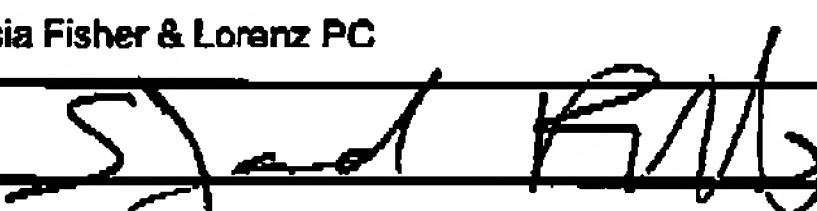
PTO/SB/21 (09-04)

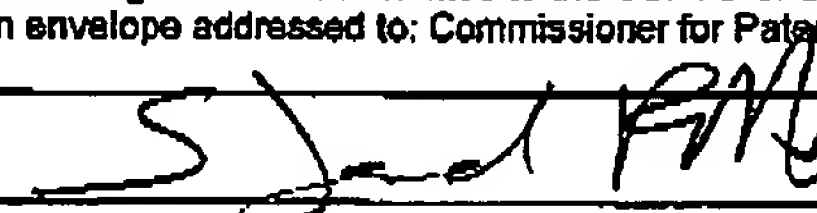
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/176,639	
	Filing Date	10/20/1998	
	First Named Inventor	Richard Robert Schediwy	
	Art Unit	2675	
	Examiner Name	Kumar, Sriakshmi K.	
Total Number of Pages in This Submission	8	Attorney Docket Number	028.1108Z1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Pre-Appeal Brief Request for Review; and Arguments Accompanying Pre-Appeal Brief Request for Review.
Remarks _____		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Ingrassia Fisher & Lorenz PC	
Signature		
Printed name	S. Jared Pitts	
Date	July 22, 2005	Reg. No. 38,579

CERTIFICATE OF TRANSMISSION/MAILING			
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Signature			
Typed or printed name	S. Jared Pitts	Date	July 22, 2005

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number	Filed
on <u>July 22, 2005</u>		09/176,639	10/20/1998
Signature <u>S. Jared Pitts</u>		First Named Inventor	
Typed or printed name <u>S. Jared Pitts</u>		Richard Robert Schediwy	
		Art Unit	Examiner
		2675	Kumar, Srilakshmi K.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>38,579</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Appl. No.	:	09/176,639	Confirmation No. 2112
Applicant	:	Richard Robert Schediwy	
Filed	:	October 20, 1998	
TC/A.U.	:	2675	
Examiner	:	Kumar, Srilakshmi K.	
Docket No.	:	20864.00600 (028.1108Z1)	
Customer No.	:	29,906	

ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW**I. Status of Claims**

Claims 16, 21-40, 42-50 and 52-63 are currently pending in the application, with claims 16, 37, 42, 52, and 63 being independent.

In general, the claimed invention is directed toward a touch pad system that uses capacitance to detect the presence of objects. Using the language of independent claim 52, the touch pad includes a conductive touch layer, where the "conductive touch layer has a conductivity selected to create an image of said conductive object that is larger than an area of contact of said conductive object to thereby increase the capacitance of the formed capacitor and facilitate sensing of the capacitance to determine a position of the conductive object." Thus, the touch pad system uses a conductive touch layer to increase capacitance, and thus improve the performance of the touch pad system.

II. Rejections under 35 U.S.C. § 103

In the office action dated Sept 22, 2004, claims 16, 21-23, 25, 27-33, 37-40, 42-50, 52-57 and 60-62 were variously rejected under 35 U.S.C. § 103(a) as being unpatentable over Grabner et al (U.S. Patent No. 4,731,694), in view of Miller et al (U.S. Patent No. 5,374,787).

As to independent claims 16, 37 and 52, the Examiner stated that Grabner disclosed a touch pad system comprising a sensor layer and an insulative layer (citing FIG. 1 items 7, 8 and 24, and column 3 lines 20-22, 31-61 and column 4, lines 26-30.) The Examiner noted that in one special embodiment of the touch pad the insulative layer 24 also comprises a metallized layer as a conductor on an upper flat surface. **The Examiner then admitted that Grabner does not disclose the touch layer having a conductivity selected to create an electrical image of a conductive object that is larger than an area of contact of said conductive object contacting said touch layer.** However, the Examiner then stated that Miller discloses, in column 8, line 58 to column 9, line 25, a touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object, and wherein said sensor layer capacitively detects the image of said conductive object when a user places a conductive object proximate said touch layer. The Examiner then concluded that it would be have been obvious for one of ordinary skill in the art to combine the references.

In a response to this rejection filed December 7, 2005, applicants argued that the Examiner has mischaracterized the Grabner and Miller references. With regard to the touch pad in Grabner, applicants noted that the touch pad disclosed in Grabner is best described a resistive-based touch pad where a change in resistance is used to determine object location. Specifically, a pressure-dependent resistance is coupled to fixed capacity and used as the measuring variable. See the abstract of Grabner. See also column 4, lines 37-63 and FIG. 2 that illustrates an equivalent circuit diagram for the Grabner touch pad and describe it as being based upon a change in resistance due to pressure on the touch pad. Thus, Applicants

argued that nowhere is Grabner described as capacitively detecting an object or “an image of the conductive object” as recited in independent claim 52.

Furthermore, applicants noted that the covering 24 of Grabner is described as metallized on its upper flat side and electrically grounded, with the metallization effective as a shield. See column 4, lines 26-29. Applicants submitted that such a presumably high-conductivity, grounded layer would hinder any sort of effective capacitive detection of an image of a conductive object. **Thus, applicants argued that Grabner does not teach capacitive detection, nor could the metallized layer 24 be used to generate an image that is capacitively detected.**

Then, with regard to Miller, applicants argued that Miller does not teach a touch layer “having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object”. Instead, Miller specifically teaches an **insulative** touch layer. See column 8, lines 58-60 and FIG. 1D, where Miller teaches “An **insulating layer 24** is disposed over the sense pads 22 on the top surface 16 to **insulate** a human finger or other object therefrom” (emphasis added). Applicants noted that FIG. 1D clearly shows the insulating layer 24 on top the device. Thus, insulating layer 24 would clearly comprise the “touch layer” of the device. Clearly, any conductive elements described by Miller are in the underlying sensor layers, and would not be touched and thus not be part of any “touch layer”.

Thus, applicants argued that Miller clearly teaches an insulative touch layer, and that Miller likewise fails to teach a touch layer having any specified conductivity. Furthermore, applicants argued that it fails to teach the conductivity selected to create an “image larger than an area of contact”.

In response to these arguments, the Examiner has issued a final rejection dated April 22, 2005, from which Applicants now make this appeal. **In this final rejection, the Examiner first maintained the original rejections based on Grabner and Miller.** Then, in

response to Applicants arguments, the Examiner noted that Applicants have argued that Miller discloses an insulative touch layer. See final the final rejection page 12, item 8. The Examiner however, failed to address applicants' arguments with regard to Miller teaching only an insulative touch layer.

Instead, the Examiner then states that Grabner discloses that the insulative layer 24 also comprises a metallized touch layer as a conductor on the upper surface, and then states it would have been obvious that this extra layer shows the three layers of the touch pad with the sensor layer on the bottom, the insulative layer on the top of the sensor layer and the conductive layer on top the insulative layer. The Examiner then states that this order could be advantageous as to have better touch detection. Thus, the Examiner concludes that the "conductive touch layer is taught by Grabner". See page 13, line 3, of the April 22, 2005 final office action.

However, this directly contradicts previous statements by the Examiner. As stated above, the Examiner has repeatedly admitted that Grabner does not disclose the touch layer having a conductivity selected to create an electrical image of a conductive object that is larger than an area of contact of said conductive object contacting said touch layer. See page 3 of the final office action dated April 22, 2005.

III. Arguments

The Examiner has failed to make a prima facie case of obviousness. Specifically, the Examiner has failed to show that either reference teaches a conductive layer having "a conductivity selected to create an image of said conductive object that is larger than an area of contact of said conductive object to thereby increase the capacitance of the formed capacitor and facilitate sensing of the capacitance to determine a position of the conductive object" as is recited in independent claim 52, and similarly recited in other independent claims. Specifically, the Examiner has previously admitted that while Grabner teaches a touch sensor with a conductive layer, it does not teach a conductive layer having a conductivity selected to create an image of said conductive object that is larger than an area of contact of said

conductive object to thereby increase the capacitance of the formed capacitor and facilitate sensing of the capacitance to determine a position of the conductive object. Furthermore, Miller clearly does not teach any sort of conductive touch layer. Instead Miller only teaches an insulative touch layer.

Thus, neither reference teaches a conductive touch layer having a conductivity selected to create an electrical image of a conductive object that is larger than an area of contact of said conductive object contacting said touch layer. Thus, the rejection cannot stand and must be withdrawn.

IV. Conclusion

In view of the foregoing, it is submitted that the Examiner's reliance upon Grabner and/or Miller alone does not support an obviousness rejection of independent Claims 16, 37, 42, 52, and 63. As such, and because claims 21-36, 38, 39, 40, 43-50, and 53-62, depend from one of the independent claims, the above-noted rejections should be withdrawn. Hence, Applicants request that the reviewing panel find that the present application is in condition for allowance.

Respectfully submitted,

INGRASSIA FISHER & LORENZ

Dated: July 22, 2005

By: 

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